

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/804,585
Confirmation No. : 7261
Applicant : Kathleen Nylund Jackson
Filed : March 18, 2004
Title : Progressive Game with Bonus
TC/A.U. : 3715
Examiner : Kang Hu

Docket No. : 247079-000299USPT
Customer No. : 70243

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Commissioner:

This Appeal Brief is filed pursuant to the Appellants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 1-38 in the December 1, 2008 Final Office Action. (Exhibit B). An amendment and response to the Final Office Action was filed on February 27, 2009. An Advisory Office Action was mailed on April 1, 2009. (Exhibit C). A Notice of Appeal is filed herewith. The due date for this Appeal Brief is two months from the mailing date of the Notice of Appeal and this brief is being filed with a petition for a two month extension of time.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the Assignee, WMS Gaming, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

3. STATUS OF THE CLAIMS

Claims 1-8, 10, 15-21 and 23-28 remain in the application for further prosecution. Claims 9, 11-14 and 22 have been canceled previously.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the last amendment filed on May 14, 2008.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for awarding randomly selected bonuses for selected ones of a community of players as shown in Figs. 1 and 5-11. Claim 1 generally relates to a method of playing a gaming system 10 played by a plurality of players where a jackpot is awarded. *See* ¶ 46, Figs. 1 and 5-11,

U.S. Publication No. 2005/0014548¹ (Exhibit A), Specification, p. 11, ll. 11-25. Players play an underlying wagering game 20 in which wagers are made by players. (Ex. A, ¶¶ 35, 46, Specification, p. 8, ll. 14-15, p. 11, ll. 20-25). When an outcome occurs in the underlying wagering game 20 that identifies that a jackpot is to be awarded to at least one of the players, a special bonus event for all of the players presently playing the underlying wagering game is entered providing a chance to be awarded bonuses. (Ex. A, ¶¶ 35, 78, Specification, p. 8, ll. 15-18, p. 20, ll. 4-9). Bonuses to be awarded in the special bonus event are randomly selected. (Ex. A, ¶ 37, Specification, p. 8, ll. 23-25). More than one but less than all of the players are randomly selected to be awarded the randomly selected bonuses. (Ex. A, ¶¶ 37, 78, 87, Specification, p. 8, ll. 23-25, p. 20, ll. 9-12, p. 21, ll. 5-10). At least one player is excluded from being awarded any bonus. (Ex. A, ¶ 35, Specification, p. 8, ll. 15-17). The randomly selected bonuses are in addition to any awards the players may win during continued play of the underlying wagering game. (Ex. A, ¶ 77, Specification, p. 19, l. 25 to p. 20, l. 2).

Claim 21 generally relates to a method of playing a gaming system 10 played by a plurality of players where a jackpot is awarded. (Ex. A, ¶ 46, Specification, p. 11, ll. 20-25, Fig. 1). Players are permitted to play underlying wagering games 20 in which wagers are made by the players. (Ex. A, ¶ 35, Specification, p. 8, ll. 14-15). When an outcome occurs in one of the underlying wagering games 20 that identifies that a jackpot is to be awarded to at least one player, a special bonus event for all players presently playing the underlying wagering games is entered providing a chance to be awarded bonuses. (Ex. A, ¶ 35, 78, Specification, p. 8, ll. 15-17, p. 20, ll. 5-9). Bonuses to be awarded are randomly awarded. (Ex. A, ¶ 37, Specification, p.

¹ The Publication for the application at issue is being attached for convenience as Exhibit A. Applicant is also providing the corresponding specification page and line number in this and following sections.

8, ll. 23-25). More than one but less than all players are randomly selected to be awarded the randomly selected bonuses in addition to any awards the some of the players may win during continued play of the underlying wagering games. (Ex. A, ¶¶ 37, 78, 87, Specification, p. 8, ll. 23-25, p. 20, ll. 9-12, p. 21, ll. 5-10). At least one player is excluded from winning any award. (Ex. A, ¶ 35, Specification, p. 8, ll. 15-17). The randomly selected bonuses are based upon a progressive bonus jackpot. (Ex. A, ¶ 89, Specification, p. 21, ll. 20-23).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 1-8, 10, 15-21 and 23-28 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano (U.S. Pat. No. 6,887,154 attached as Exhibit D) in view of Acres (U.S. Pat. No. 6,319,125 attached as Exhibit E).

Claims 1-8, 10, 15-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano (Ex. D) in view of Acres (Ex. E). The Final Office Action asserted that Luciano teaches a method of playing a gaming system played by a plurality of players. (Ex. B, p. 2. The Final Office Action cited the abstract, Col. 2, ll. 20-67 and Col. 4, ll. 29-60 of Luciano as disclosing playing an underlying wagering game, when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of the players, entering a special bonus event for all of the players. (Ex. B, p. 2). The Final Office Action noted that Luciano “teaches that players who have an active status at the time of the progressive award triggering event are entitled to share in the secondary progressive prize (col. 3, ll. 1-3)” is analogous to all of the players playing the underlying wagering game. (Ex. B, p. 3). The Final Office Action noted that Acres discloses seven different formats and combination of

bonuses for players including after specific trigger events, randomly selecting bonuses to be awarded in the special bonus event. The Final Office Action asserts that Acres discloses randomly selecting more than one but less than all of the players to be awarded the randomly selected bonuses. (Ex. B, p. 3).

7. ARGUMENT

For the Board's convenience, claims 1-8, 10, 15-21 and 23-28 are one group that will stand or fall together. The present claims allow for some but not all random players playing over multiple gaming terminals the opportunity to be selected for a random award when one of the players triggers a communal bonus event. Neither of the references of record disclose these concepts.

A. Claims 1-8, 10, 15-21 and 23-28 Were Improperly Rejected Under 35 U.S.C. 103(a) As Being Obvious Over Luciano In View Of Acres

1. The Deficiencies in Luciano And Acres

Luciano relates to a system that awards all active players playing a game. A first award is paid to the player triggering a jackpot while a secondary bonus from a separate award pool is paid to all of the other players. (Abstract). The Final Office Action concedes that Luciano does not disclose randomly selected bonuses to be awarded and randomly selecting more than one but less than all of the players to be awarded the randomly selected bonuses. (Ex. B, pp. 2-3).

Acres generally relates to a gaming system with bonus prizes that may include one of several promotions such as a cash bonus, a mystery prize, a progressive jackpot, etc. (Ex. E, Col. 4, ll. 21-30 and Fig. 1). Acres discloses seven different forms of bonus prizes, however, only three of the bonus prizes are awarded to some subset of the players if one player hits a jackpot,

namely, the cash bonus, mystery bonus and progressive bonus described on Col. 4, l. 65 to Col. 9, l. 13 of Acres. (Ex. E). The other forms of bonuses in Acres such as welcome back bonus, match play bonus or personal progressive bonus are awarded only to qualified individual players alone. (See e.g., Ex. E, Col. 9, ll. 14-19, ll. 58-61, Col. 12, ll. 58-61 and Col. 14, ll. 61-63). For the multiple player bonuses, only one form of bonus prize can be awarded since the awarding of each of the forms of bonus prize is triggered by the coin-in collected pushing a prize pool over a certain threshold amount, such as a cash bonus amount or a randomly determined amount that is specific to that form of bonus prize. (See e.g., Col. 4, l. 66 - Col. 5, l. 1, Col. 5, l. 66 – Col. 6, l. 3, Col. 8, ll. 1-9, Ex. E). Since the thresholds for each form of bonus prize are triggered from the coin-in, there cannot be two different forms of bonus prizes in Acres, since the lower threshold bonus prize would always be triggered and therefore a second bonus prize could never be awarded. Applicant therefore contends that the relevant disclosure in Acres is a specific form of bonus prize such as the mystery prize as discussed on Col. 5, l. 65 to Col. 7, l. 64. (Ex. E).

For each of the cash bonus, mystery bonus and progressive bonus forms, the bonus prize is awarded to a selected eligible player, while all the remaining players are awarded a fixed consolation prize. (see e.g., Ex. E, Col. 5, ll. 41-45 for the cash bonus prize, Col. 7, ll. 35-40 for the mystery bonus, Col. 55-59 for the progressive jackpot bonus prize). Acres does not disclose randomly selecting players as all the players in Acres receive a consolation prize in any of the multi-player “bonus forms.” Thus Acres does not disclose excluding players from being awarded any prize as required by the pending claims.

In the pending claims, the exclusion of players heightens the anticipation when a jackpot is triggered in the bank of eligible games as players anticipate receiving an award but understand

that they could be excluded. Thus, excitement is generated from the potential exclusion of the player from any prize unlike in Acres where all players are guaranteed either the primary prize or a consolation prize.

The Advisory Action has asserted that “in Luciano, though all players may receive a consolation prize, not all receive it from the mystery prize taught be Acres. Acres teaches random selection of mystery prizes based on the mystery threshold to randomly award a car, large cash prize or a rapid hit mystery prize randomly awards progressively larger cash prizes to the winners.” (Ex. C, p. 3). Applicant respectfully submits that the Advisory Action has confused the nature of Luciano and Acres. As explained above, Luciano discloses awarding a prize to one of the players and consolation prizes to the rest of the eligible players. Acres discloses exactly the same system, one player is awarded a mystery prize when the mystery threshold is exceeded, and the mystery prize to the one player is selected randomly according to the section cited by the Advisory Action. None of the other players receive the mystery award. However, the rest of the players are guaranteed of receiving the consolation prize as explained by Acres in the sequence that awards the mystery prize as explained in Col. 7, ll. 36-40. (Ex. E). The “mystery prizes” in Acres do not relate to multiple players receiving the mystery prizes. Instead, the “mystery prizes” refer to one player receiving one of a selection of “mystery prizes.”

2. Acres And Luciano Do Not Disclose Excluding One Player And Randomly Selecting More Than One But Less Than All of the Players To Be Awarded Randomly Selected Bonuses

Independent claim 1 requires “excluding at least one player from being awarded any bonus” in addition to “randomly selecting more than one but less than all of said players to be awarded the randomly selected bonuses and excluding at least one player from any bonus.”

Independent claim 21 requires “excluding at least one player from winning any award.” All of the players in the Acres’ “forms” of prize sequences either are awarded either the jackpot prize or a consolation prize. Even within the mystery bonus prize form relied on by the Final Office Action, multiple mystery bonuses may be available for certain players but other players who do not receive the multiple mystery bonuses are guaranteed a consolation prize. (Ex. E, Col. 7, ll. 36-43). Thus, Acres does not disclose excluding players from any prize, since only one player receives the promotional prize and all other players receive the consolation prize in the cash bonus, mystery bonus and progressive multi-player “bonus forms.”

The Final Office Action has cited Col. 4, ll. 30-32 of Acres which states “the bonus prize can also be tiered into a main bonus prize and multiple secondary bonus prizes, plus optional consolation prizes, and similar combinations.” (Ex. B, p. 4). This section only relates to the bonus prize that is awarded to the prize player, Acres is silent as to whether such prizes may be awarded to any other players in addition to the other awards. However, the remainder of Acres indicates that the bonus is only awarded to one player and not remaining players as required in the claims. The Final Office Action also cites Col. 5, ll. 41-43 which states that “a consolation prize is awarded at all active gaming devices 300 except the winning gaming device 300.” (Ex. B, p. 4). This section supports Applicant’s position, since a player may only receive a bonus prize (thereby precluding the award of a consolation prize to that player) or a consolation prize. Both claims 1 and 21 require that “said randomly selected bonuses being in addition to any awards some of said players may win during continued play of the underlying wagering game” and “excluding at least one player from being awarded any bonus.” Acres therefore does not anticipate these elements since Acres only allows a player to win a bonus prize or a consolation

prize and not both. Further Acres allows all players to win either the bonus or the consolation prize and therefore does not exclude one player from being awarded any bonus.

The Advisory Action has asserted that the Acres should be interpreted as disclosing randomly selected bonuses because the gaming industry is highly regulated and some minimum percentage of all coin-in must be paid out at each gaming device. (Ex. C, p. 3). The Advisory Action further reasons that “the bonus promotions create bonus prizes which are awarded in addition to the jackpots based on a separate set of payout tables of criteria ... plus optional consolation prizes, and similar combinations.” (Ex. C, p. 3). The Advisory Action further indicates that the applicant is assuming that after the jackpot is triggered, that each of the machines active have not paid out at least the minimum percentage of all coin-in regulated by the industry and also that there’s unlimited amount of money in the bonus pool to be paid out to the players, but the Advisory Action indicates that Col. 4, l. 54 of Acres discloses that “at the appropriate time, the bonus prize is awarded based on predefined bonus criteria at an eligible gaming device, thereby depleting the bonus pool.” (Ex. C, Ex. E). The Advisory Action “interprets this passage to mean that bonus prize can be optional consolation prizes, which does not require all players presently playing the underlying wagering game to be awarded a bonus prize.” (Ex. C, p. 3).

Applicant respectfully submits that the Advisory Action has overstretched the disclosure in Acres. First, there is nothing in Acres and the Advisory Action has cited no evidence that Acres can be interpreted to support some but not all of the players receiving optional consolation prizes. Second, the Advisory Action has misinterpreted the teachings of Acres. The section of Acres cited by the Advisory Action relates solely to the selection of the bonus prize for the first

player to trigger the consolation prize for all of the other players. This interpretation is consistent with the mechanism in Acres which awards the bonus prize when the pool reaches a threshold sufficient to fund both the bonus prize and the consolation prizes. This meets the regulatory requirements because the threshold is set at the required minimum percentage of coin-in to be paid back to players from a machine. There is simply nothing in Acres disclosing one player that does not receive either the main bonus prize or a consolation prize. To the contrary, Acres specifically discloses that all players receive at least the consolation prize if they do not receive the bonus award. (Ex. E, Col. 7, ll. 36-43).

The Advisory Action also notes that the “Personal Progressive Bonus prize enables each player to grow their own mystery award which only they are eligible to win” citing Col. 15, ll. 17-23 that all gaming devices participate and no consolation prizes are awarded.” (Ex. C, p. 3). This section does not anticipate the elements of the claims. The awarding of a personal progressive prize without a consolation prize as explicitly disclosed by the cited section means that no other players can receive a bonus award in addition to an initial triggering jackpot award and therefore does not anticipate the claims which require at least some other players to receive a bonus award.

3. Neither Acres Nor Luciano Disclose A Special Bonus Event When An Outcome Occurs in The Wagering Game That Identifies the Jackpot

Independent Claims 1 and 21 are also allowable over the Acres and Luciano combination. These claims require “when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of the players” a special bonus event is entered for all of the players. Luciano does not disclose entering into a special bonus event because when the progressive is triggered in Luciano, all of the players automatically receive either the primary

prize or the secondary prize. Acres also does not identify that a jackpot or any other bonus award is awarded based on an outcome occurring in the underlying wagering game. Acres discloses triggering a jackpot when the coin-in is collected, prior to any outcome in the wagering game. For example, in the mystery bonus form, the bonus is triggered to allow the cash bonus pool to exceed a cash bonus amount or the mystery threshold amount for the mystery bonus or progressive jackpot. (Ex. E, Col. 4, l. 66 - Col. 5, l. 1, Col. 5, l. 66 – Col. 6, l. 3, Col. 8, ll. 1-9).

The Advisory Action asserts that Luciano specifically teaches the element in Col. 3, ll. 5-14 that discloses “award triggering events which when triggered by a player entitling the player to the primary progressive prize. Additionally players who have an active status at the time of the progressive award triggering event are entitled to share in the secondary progressive prize.” (Ex. C, p. 3). This section does not support or suggest entering in a special bonus event as required by the claims. There is no bonus event as the secondary progressive prize is simply awarded to all eligible players. As Luciano explains further, “the share of the secondary prize may be distributed to players using various strategies including an equal share, or a proportional share based on one or more criteria.” (Ex. D, Col. 3, ll. 14-13).

4. Neither Of The References Disclose Randomly Selecting Bonuses

Claims 1 and 21 also require “randomly selecting bonuses to be awarded in the special bonus event.” The Final Office Action has asserted that the mystery bonus prize in Acres as disclosing the random selection of bonuses since there are three kinds of mystery bonuses to be awarded. (p. 4). However, the mystery bonus actually randomly selects the jackpot won by the initial triggering player such as between a car, a large cash prize or a rapid hit mystery prize which is awarded to one player only. (Col. 7, ll. 27-30). Therefore, the mystery prize is awarded

to a single player and the consolation prize is a set amount awarded to the remainder of the players and therefore does not randomly select bonuses for the other players as required by the claims. (Col. 7, ll. 31-32). The independent claims require randomly selecting bonuses for multiple players excluding at least one player, and not simply randomly selecting one bonus jackpot to a single player as disclosed by Acres. Since Acres does not disclose randomly selecting multiple bonuses for players other than the jackpot winner, it does not anticipate the pending claims. The Final Office Action has explained that “these prizes to be awarded randomly instead of simple one bonus jackpot argued by the applicant” citing Col. 6, ll. 19-24 of Acres. (Ex. B, p. 5. Ex. E). However, this section only cites that there can be larger secondary cash prizes and consolation prizes. Nothing in this section indicates that other players are randomly awarded such an award or awards. In fact, a consistent reading of this section in the context of Acres would be that all players are awarded a prize, either a secondary cash prize or a consolation prize.

The Advisory Action has cited Col. 6, ll. 5-7 of Acres that states “the mystery threshold is randomly selected before each new promotion starts and must fall within a range of pre-defined values” and therefore the players are randomly selected to receive different prizes. (Ex. C, p. 3, Ex. E). This section does not support randomly selected the awards, rather the section discloses randomly selecting the parameter at which the award is triggered but not a random value for the award.

8. CLAIMS APPENDIX

A clean copy of the claims 1-8, 10, 15-21 and 23-28 involved in the appeal is included in the Claims Appendix.

9. EVIDENCE APPENDIX

A copy of the evidence relied upon by the appellant is included in the Evidence Appendix and is herein referenced. A list of evidence and where each was entered in the record is included in the Index to the Appendices.

10. RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, no information is provided in the Related Proceedings Appendix.

Conclusion

It is the Applicant's belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicant's undersigned attorney at the number shown.

Respectfully submitted,

Date: April 29, 2009

By: /Wayne L. Tang/ - Reg. No. 36,028

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